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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,649	03/29/2004	Stephen G. Nelson	744-P-6	3406

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EXAMINER	
GRAY, LINDA LAMEY	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/812,649	NELSON, STEPHEN G.	
	Examiner	Art Unit	
	Linda L Gray	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The use of trademarks has been noted in this application. They should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Also, the status of the parent application should be updated in the specifcation.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a substrate having a second surface with dark colored adhesive thereon, does not reasonably provide enablement for a second surface with a dark colored surface where an adhesive is then applied thereto. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The specification indicates that the adhesive is the dark colored material applied to the substrate to make such dark colored on one side. Then the liner is applied over the adhesive. However, claim 11 recites the addition of an adhesive layer over a dark colored surface of the substrate followed by the addition of a liner to the adhesive. Thus, claim 11 essentially adds a second layer (i.e., an adhesive layer) not discussed within the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shields (US 5,773,110) in view of Andriash (US 5,679,435) and Mimura et al. (US 5,002,825).

Claim 1, Shields teaches a method for producing a one-way see-thru panel (c 1, L 1-9). The method includes (a) providing opaque light colored substrate 80 having opposite first and second surfaces, (b) applying dark pigmented adhesive 82, (c) applying release liner 83 over adhesive 82, (d) perforating substrate 80 and liner 83 with a distinct hole pattern, (e) applying an imperforate barrier 85 over liner 83, and (f) applying an image to the second surface of substrate 80 via printing or painting (c 5, L 9-24).

Shield does not teach applying the image by inkjet printing.

Andriash teaches a method for producing see-thru panel including applying an image to a substrate via printing or painting where printing includes inkjet printing (c 5, last para).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields applying the image by inkjet printing because Andriash teaches in the same art that inkjet printing is an alternative to painting where Shields teach painting or printing and it is obvious to replace one method of applying an image with another art recognized alternative method for applying an image.

Shields modified does not teach an inkjet encapsulating coat under the image.

Mimura et al. teach that printing with inkjet printers often includes a long drying time, a non-smooth surface, poor transcription, and blotting leading to an unclear image. Mimura et al. teach overcoming these shortcomings by providing an inkjet encapsulating coat under an inkjet printed image (c 1).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified an inkjet encapsulating coat under the image because Mimura et al. teach that printing with inkjet printers often includes a long drying time, a non-smooth surface, poor transcription, and blotting leading to an unclear image and that such can be overcome by providing an inkjet encapsulating coat under an inkjet printed image.

With respect to the claim limitation of the coating being applied before perforating, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified application of the coating before perforating to avoid application of the coating within the perforations which would distort the ability to view of image.

Claim 2, *Shields does not teach a specific material for panel 80, i.e., that panel 80 is a polymer (plastic) of polyester, vinyl, or polyolefins.*

However, display panels of polymers (i.e., plastic) of these materials are conventional because such are slightly flexible and conform well to slightly configured surfaces, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields that panel 80 is a polymer (plastic).

Claim 3, in Shields modified the coating includes a resin because Mimura teach such.

Claim 4, Shields teaches a method for producing signage for application to a transparent substrate which is a window (c 1, L 1-9). The method includes (a) providing opaque light colored substrate 80 having opposite first and second surfaces, (b)

applying pigmented adhesive 82 to the first surface, (c) applying release liner 83 over adhesive 82, (d) perforating substrate 80 and liner 83 with a distinct hole pattern, (e) laminating an imperforate barrier 85 over liner 83, and (f) applying an image to the second surface of substrate 80 via printing or painting (c 5, L 9-24). Shields teaches removing barrier 85 and liner 83 to expose adhesive 8 and contacting adhesive 82 to the transparent substrate; however, it is noted that these claimed steps are intended use limitations of the article made by the claimed method only. Such are not considered part of the claimed method upon which patentability is based.

Shield does not teach applying the image by inkjet printing.

In view of Andriash, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields applying the image by inkjet printing because Andriash teaches in the same art that inkjet printing is an alternative to painting where Shields teach painting or printing and it is obvious to replace one method of applying an image with another art recognized alternative method for applying an image.

Shields modified does not teach an inkjet encapsulating coat under the image.

In view of Mimura et al., it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified an inkjet encapsulating coat under the image because Mimura et al. teach that printing with inkjet printers often includes a long drying time, a non-smooth surface, poor transcription, and blotting leading to an unclear image and that such can be overcome by providing an inkjet encapsulating coat under an inkjet printed image.

With respect to the claim limitation of the coating being applied before perforating, it would have been obvious to a person of ordinary skill in the art at the

time the invention was made to have provided in Shields modified application of the coating before perforating to avoid application of the coating within the perforations which would distort the ability to view of image.

Shields does not teach a specific material for panel 80, i.e., that panel 80 is a polymer (plastic).

However, display panels of polymers (i.e., plastic) are conventional because such are slightly flexible and conform well to slightly configured surfaces, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields that panel 80 is a polymer (plastic).

Claims 5-7, *Shields modified does not teach inks that are dye based, pigmented, or solvent based (claim 5) and does not teach piezo ink applicators or thermal ink applicators (claims 6-7).*

However, such dyes and applicators are conventional in the art, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified these inks and applicators because it is obvious to replace one type of ink and applicator with other art recognized alternative inks and applicators used for the same purpose.

Claim 8, Shields teaches a method for producing printable signage for application to a transparent substrate which is a window (c 1, L 1-9). The method includes (a) providing opaque light colored substrate 80 having opposite first and second surfaces with pigmented adhesive 82 (i.e., dark) on one of the surfaces and (b) perforating substrate to provide see through visibility when viewed from the adhesive side surface (c 5, L 9-24). Shields also teaches applying an image to the other surface of substrate 80 via printing or painting.

Shield does not teach applying the image by inkjet printing over an inkjet encapsulating coat.

In view of Andriash and Mimura et al., it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields applying the image by inkjet printing because Andriash teaches in the same art that

inkjet printing is an alternative to painting where Shields teach painting or printing and it is obvious to replace one method of applying an image with another art recognized alternative method for applying an image. Also, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified an inkjet encapsulating coat under the image because Mimura et al. teach that printing with inkjet printers often includes a long drying time, a non-smooth surface, poor transcription, and blotting leading to an unclear image and that such can be overcome by providing an inkjet encapsulating coat under an inkjet printed image.

***Claims 8-9**, Shields does not teach a specific material for panel 80, i.e., that panel 80 is a polymer (plastic) of polyester, vinyl, or polyolefins.*

However, display panels of polymers (i.e., plastic) of these materials are conventional because such are slightly flexible and conform well to slightly configured surfaces, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields that panel 80 is a polymer (plastic).

Claim 10, in Shields modified the coating includes a resin because Mimura et al. teach such. **Claim 11**, Shields teaches applying adhesive 84 and liner 85 on the adhesive side surface. **Claim 12**, as shown above, Shields modified teaches applying an image to the other surface of panel 80.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg
August 9, 2004

LINDA GRAY
PRIMARY EXAMINER